

The present amendment is submitted in response to the Office Action dated January 17, 2007, which set a three-month period for response, making this amendment due by April 17, 2007.

Claims 1-13 are pending in this application.

In the Office Action, the specification was objected to for an informality. Claims 1-10 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1, 3-4, and 8-9 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,747,343 to Gellert. Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gellert in view of U.S. Patent No. 5,207,028 to Timmons.

The Applicants note with appreciation the allowance of claims 2 and 5-7 if rewritten to overcome the rejection under Section 112, second paragraph, and to include all of the limitations of the base claim and intervening claims.

In this amendment, the disclosure has been amended on page 5 to clarify that the insertion tool 12, rather than the hub, is designed as a cutting disc.

For purposes of clarification, submitted herewith is amended Fig. 1, a schematic illustration of the arrangement of the hub 16, which includes missing reference numeral 18.

In addition, a new Fig. 1a is provided to illustrate the arrangement of the elements 12, 16 and 18. Support for the features shown in the amended and new figures is disclosed on page 5, lines 10-13. Specifically, this portion of the specification discloses that the hub 16 as well as the abrasive body 18 are different parts of the insertion tool 12 and that the abrasive body 18 is located

around the hub 16 and is fastened to the hub 16 by means of fastening elements 20.

New Fig. 1b also is included to more clearly show the features of claim 3.

The Applicants respectfully submit that the amended and new figures do not contain or constitute new matter, since the features shown in these drawings were disclosed in the original specification as filed.

Turning now to the objection to the specification and rejection of the claims under Section 112, second paragraph, in particular, the Examiner's questions regarding the "insertion tool", an insertion tool is a device which could be inserted and fastened into or onto a centering collar of a driving flange of a machine tool (specification, page 5, lines 15-16). This insertion tool can be designed as a cutting disc, for example (specification, page 5, lines 13-15), and the machine tool, for example, is an angle grinder as shown in Fig. 1 and disclosed on page 5, line 2. The entire insertion and fastening process is disclosed in detail on page 5, line 15 to page 6, line 14. Therefore, the Applicants respectfully submit that the features of an insertion tool are sufficiently supported and explained in the specification.

In the Office Action, the Examiner has objected to a lack of clarity of the connection of the insertion tool 12 to all of the other elements recited in the claims, especially the correlation of the insertion tool 12 to the abrasive body 18 and the hub 16. As disclosed on page 5, lines 10-13, and now shown in Fig. 1, the insertion tool 12 consists of the abrasive body 18 and the hub 16; the abrasive body 18 is located around the hub 16 and is fastened to the hub 16 by

means of fastening elements 20. Therefore, the hub 16 is the part of the insertion tool 12 which connects the insertion tool to the driving flange 22 of the angle grinder 2 and the abrasive body 18 is the working surface for processing a work piece. In addition, the insertion tool 12, not the hub 16, is designed as a cutting disc (specification, page 5, lines 13-16).

With regard to the objection due to the indefiniteness of the scope of the invention, the Applicants submit that the above explanation regarding the insertion tool, its relation to the machine tool, to the hub and to the abrasive body addresses this objection, as do amended Fig. 1 and Figs. 1a and 1b.

Claim 1 was amended to address the objections and rejection under Section 112, second paragraph, and to more clearly distinguish the invention over the cited references. Amended claim 1 now includes the feature that the opening has a “rear region which is realized due to the convex section and which is arranged in release direction behind the stop”.

Claim 2 was amended to delete the phrase “in particular, at least 3 mm”. New claim 12 now recites that feature. In addition, in amended claim 2, the term “tangential” was replaced with “circumferential”.

With regard to the rejection of claim 3 for lack of clarity, the phrase “the stop (66, 88) is oriented such that it is rotated” characterizes no dynamic process, and in particular, no rotational process. It defines the orientation of the stop versus the direction of rotation and a radial direction, respectively. For clarity, Fig. 1b is provided. In this figure, the radial direction (100) extends from the center (102) of the hub (16) through one point of the stop (66) to the

periphery. A straight line (104) which is the extension of the longitudinal orientation of the stop (66) is depicted. The straight line (104) deflects in a counterclockwise direction from the radial direction (102) about an angle (106), which has a numeric value between 2° and 10°, and specifically, 5.5°, as disclosed on page 7, lines 21-23.

Therefore, the Applicants respectfully submit that an amendment of claim 3 is not necessary in view of the comments above.

Regarding the rejection of claim 4 as indefinite, the phrase “in particular” was deleted from this claim as well and the term “tangential” was replaced with “circumferential”.

With regard to the objections to claims 7 and 8, again the term “tangential direction” was replaced with “circumferential direction”; the equivalency of these terms is disclosed on page 1, lines 15-18 and the orientation of the direction is shown in Figs. 2 and 3.

Also in this amendment, new independent claim 11 was added, which includes the features of claim 1, but is directed to the embodiment of the insertion tool 12 as a cutting disc as disclosed on page 5, lines 13-15.

As noted above, new claim 12 was added, which depends from claim 1 and includes the narrower limitations of claim 2.

In addition, new claim 13 was added, which depends from claim 1 and includes features shown in Fig. 5 as well as new Fig. 1b. The straight line 104 which is the extension of the longitudinal orientation of the stop 66 deflects in a counterclockwise direction from the radial direction 102 and does not cross the

center 102 of the hub 16. Therefore, it is oriented eccentrically with respect to the center 102.

Turning next to the substantive rejections of the claims, the Applicants respectfully submit that the amended and new claims define a patentably distinct set of features that is neither disclosed nor suggested by the cited references.

Gellert et al disclose a finishing disc for finishing surfaces. Circumferential spaced slots or openings, embodied as keyhole slots 48 with a forward slot portion 50 and an enlarged aperture 52 communicating with a reward portion of the slot are arranged in the finishing surface (see Gellert, Figs. 4 and 5 and column 6, line 38 to column 7, line 17).

In contrast, the present invention provides an insertion tool 12 with a hub 16, wherein the hub 16 has at least one opening 42, 80 for insertion of fastening means 40, 84 and the opening 42, 80 includes a retaining region 54 and a releasing region 56, the releasing region 56 including a stop 66, 88 for limiting a release motion of the fastening means 40, 84, wherein the opening 42, 88 has a convex section 76, 90 adjacent to the stop 66, 88 and with a rear region 76, 90 which is realized due to the convex section 76, 90 and which is arranged in release direction 64 behind the stop 66, 88 (specification, page 1, line 28 to page 2, line 11, and page 8, lines 5 through 17; Fig. 5).

Gellert et al fails to disclose ***a rear region 76, 90 which is arranged in a release direction behind the stop (end of slot 52)***. Therefore, amended claim 1 is patentable over Gellert et al.

The Applicants furthermore respectfully submit that Gellert is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of MPEP section 2131, where it is stated that “a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference”, and that “the identical invention must be shown in as complete detail as is contained in the ... claim”. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

The Timmons et al reference discloses an abrasive disc subassembly with a central aperture 28 for fastening the disc 18 to the spindle (see Timmons abstract).

Timmons et al do not teach openings for insertion of fastening means of a driving flange. Thus, claim 1 as amended also is patentable over this reference.

Because neither Gellert nor Timmons discloses the above features, then even if the references are combined, the practitioner would not be lead to the present invention as defined in the pending claims. It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01.

For the reasons set forth above, the Applicants respectfully submit that claims 1-13 are patentable over the cited art. The Applicants further request

withdrawal of the rejections and reconsideration of the claims as herein amended.

In light of the foregoing amendments and arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

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